

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: <b>Dunn</b>	§	
	§	Group Art Unit: <b>3692</b>
Serial No. <b>09/997,979</b>	§	
	§	Examiner: <b>Kramer, James A.</b>
Filed: <b>November 30, 2001</b>	§	
	§	
For: <b>System and Method for</b>	§	
<b>Calculating Parameters for a</b>	§	
<b>Commerce System</b>	§	

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**36736**  
PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

**APPEAL BRIEF (37 C.F.R. 41.37)**

This brief is in furtherance of the Notice of Appeal, filed in this case on December 4, 2006.

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0461. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

### **REAL PARTY IN INTEREST**

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

### **RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

## **STATUS OF CLAIMS**

### **A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

Claims in the application are: 2-8, 10-16, 26-32, 34-41, and 43-44.

### **B. STATUS OF ALL THE CLAIMS IN APPLICATION**

1. Claims canceled: 1, 9, 17-25, 33, and 42.
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 2-8, 10-16, 26-32, 34-41, and 43-44.
4. Claims allowed: None
5. Claims rejected: 2-8, 10-16, 26-32, 34-41, and 43-44.
6. Claims objected to: None

### **C. CLAIMS ON APPEAL**

The claims on appeal are: 2-8, 10-16, 26-32, 34-41, and 43-44.

### **STATUS OF AMENDMENTS**

There are no amendments after the Response to Final Office Action, filed November 6, 2006, amending claim 7.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

### **A. CLAIM 2 - INDEPENDENT**

The subject matter of claim 2 is directed to a method for processing a parameter for an item in an electronic order processing system, said method comprising: providing a plurality of calculation rules for calculating amounts for parameters of items; (Specification page 8, lines 15-27.) associating one or more calculation rules from the plurality of calculation rules with a calculation code, wherein the one or more calculation rules are used to produce an amount for a parameter and wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item; (Specification page 12, lines 10-15; page 16, lines 4-17; and page 19, line 17, through page 20, line 12.) associating the calculation code with an item; (Specification page 12, line 22, through page 13, line 13.) responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; (Specification page 16, lines 14-17.) and responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce an amount for the parameter for the item; (Specification page 15, lines 2-5.) and providing the amount to an output device. (Specification page 10, line 23, through page 11, line 3.)

### **B. CLAIM 10 - INDEPENDENT**

The subject matter of claim 10 is directed to an electronic order processing system for use in an ordering system responsive to a transaction request associated with an item, said electronic order processing system comprising: a computer receiving the transaction request; and a program executed on the computer for processing the transaction request and processing a parameter for the item, the program comprising: (Specification page 9, lines 1-21.) a plurality of calculation rules for calculating amounts for parameters of items; (Specification page 8, lines 15-27.) an association module for associating a calculation code with the item wherein the calculation code has an associated qualifying method that is used to determine whether the

calculation code is to be applied to the item; (Specification page 12, lines 10-15; page 12, line 22, through page 13, line 13; page 16, lines 4-17; and page 19, line 17, through page 20, line 12.) a calculation module for applying the calculation code to the item to produce an amount for a parameter for the item, wherein the calculation module initially associates one or more calculation rules with the calculation code; responsive to initiating application of the calculation code to the item, uses the qualifying method to determine whether to apply the calculation code to the item; and, responsive to a determination that the calculation code is to be applied to the item, uses the one or more calculation rules to produce the amount for the parameter for the item; (Specification page 12, lines 10-15; page 12, line 22, through page 13, line 13; page 16, lines 4-17; page 19, line 17, through page 20, line 12; and page 15, lines 2-5.) and an application module for providing the amount to an output device. (Specification page 10, line 23, through page 11, line 3.)

#### **C. CLAIM 26 – INDEPENDENT**

The subject matter of claim 26 is directed to a computer program product, in a computer readable medium, embodying a method for processing a parameter for an item, the method comprising the steps of: providing a plurality of calculation rules for calculating amounts for parameters of items; (Specification page 8, lines 15-27.) associating one or more calculation rules from the plurality of calculation rules with a calculation code, wherein the one or more calculation rules are used to produce an amount for a parameter and wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item; (Specification page 12, lines 10-15; page 16, lines 4-17; and page 19, line 17, through page 20, line 12.) associating the calculation code with an item; (Specification page 12, line 22, through page 13, line 13.) responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; (Specification page 16, lines 14-17.) and responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce an amount for the parameter for the item; (Specification page 15, lines 2-5.) and providing the amount to an output device. (Specification page 10, line 23, through page 11, line 3.)

**D. CLAIM 34 – INDEPENDENT**

The subject matter of claim 34 is directed to an electronic order processing system comprising: a computer-readable information storage medium; (Specification page 9, lines 1-7.) a procedure encoded on said storage medium for processing a parameter for an item, said procedure comprising: (Specification page 9, lines 1-7.) providing a plurality of calculation rules for calculating amounts for parameters of items; (Specification page 8, lines 15-27.) associating one or more calculation rules from the plurality of calculation rules with a calculation code, wherein the one or more calculation rules are used to produce an amount for a parameter and wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item; (Specification page 12, lines 10-15; page 16, lines 4-17; and page 19, line 17, through page 20, line 12.) associating the calculation code with an item; (Specification page 12, line 22, through page 13, line 13.) responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; (Specification page 16, lines 14-17.) and responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce an amount for the parameter for the item; (Specification page 15, lines 2-5.) and providing the amount to an output device. (Specification page 10, line 23, through page 11, line 3.)

**E. CLAIM 41 – INDEPENDENT**

The subject matter of claim 41 is directed to an electronic order processing system for processing a parameter for an item in a distributed network having a first computer and a second computer, said system comprising: a computer-readable modulated carrier signal; (Specification page 9, line 22, through page 10, line 3.) a first initiation code embedded in said signal sent from said first computer to said second computer, said first initiation code to initiate a first module for associating a calculation code with said item, wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the



item; (Specification page 12, line 22, through page 13, line 13.) a second initiation code embedded in said signal sent from said first computer to said second computer, said second initiation code to initiate a second module for applying said calculation code to said item to produce an amount, wherein said second module further comprises initially associating one or more calculation rules with said calculation code; responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; and, responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce the amount; and a third initiation code embedded in said signal sent from said first computer to said second computer, said third initiation code to initiate a third module for providing said amount to an output device. (Specification page 10, line 23, through page 11, line 3.)

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to review on appeal are as follows:

1. Whether claims 2-8, 10-16, 26-32, 34-41, and 43-44 are anticipated by U.S. Patent 5,878,400, issued to *Carter*, Method and Apparatus for Pricing Products in Multi-Level Product and Organizational Groups, (March 2, 1999).

## ARGUMENT

### A. GROUND OF REJECTION 1 (Claims 2-8, 10-16, 26-32, 34-41, and 43-44)

The Examiner rejected claims 2-8, 10-16, 26-32, 34-41, and 43-44 as being anticipated by U.S. Patent 5,878,400, issued to *Carter*, Method and Apparatus for Pricing Products in Multi-Level Product and Organizational Groups, (March 2, 1999) (hereinafter “*Carter*”). This position is not well-founded.

*Carter* does not anticipate Applicant’s claims because *Carter* does not teach a calculation code that is associated with an item in combination with using a qualifying method to determine whether the calculation code is to be applied to the item, and does not teach a qualifying method. Therefore, *Carter* does not anticipate Applicant’s claims.

*Carter* teaches determining prices using groups of products. A user can group products to produce a hierarchy. The price for a product is then determined using that product’s location in the hierarchy. *Carter*, Figure 4B, provides an example of product groups. In the example, a “hard drive” is included in the “storage devices” group, which is included in the “hardware” group, which is part of the “all products” group.

A user first groups products into product groups, which produces the hierarchy. After the user groups products, the user can then assign a price adjustment for the groups. These group price adjustments are used to determine price adjustments for selected products. “[T]he price adjustments for a particular product are determined by retrieving the price adjustments for that particular product as well as the price adjustments for other product groups that are above the particular product in the product groups hierarchy.” *Carter*, column 3, lines 52-56.

Thus, the location of a product in the hierarchy determines the price adjustment for that product. For example, a first price adjustment can be identified for the “hardware” group and a second price adjustment can be identified for the “storage devices” group. The price of a hard drive would then be adjusted using both the first and second price adjustments.

*Carter* does not anticipate Applicant’s claims because *Carter* does not teach a calculation code that is associated with an item in combination with using a qualifying method to determine whether the calculation code is to be applied to the item.

Applicant claims calculation rules that are associated with a calculation code. The calculation code is also associated with an item. The calculation code has an associated qualifying method. The qualifying method is used to determine whether to apply the calculation code to the item. If the calculation code is to be applied to the item, the calculation rules are used to produce an amount for a parameter for the item. Regardless of whether the calculation code is applied to the item, the calculation code remains associated with the item.

Thus, according to Applicant's claims, the calculation code is associated with an item, and might also be applied to an item. The claims distinguish being associated with an item from being applied to an item. Being associated with an item is not the same as being applied to an item.

In the Final Office Action mailed September 5, 2006, the Examiner asserts that the groups taught by *Carter* are analogous to the calculation code claimed by Applicant, and the price adjustments taught by *Carter* are analogous to the calculation rules claimed by Applicant. In the Advisory Action, mailed December 1, 2006, the Examiner asserts that when items are placed in groups, a qualifying method must occur which determines if the item is in the group and thus whether to apply the code.

In order to anticipate Applicant's claims, *Carter* must teach each and every feature of Applicant's claims. However, *Carter* does not teach each and every feature of Applicant's claims because *Carter* does not teach a calculation code that is both associated with an item in combination with using an associated qualifying method to determine whether the calculation code is to be applied to the item. Therefore, *Carter* does not anticipate Applicant's claims.

It appears that the Examiner is equating being associated with an item and being applied to an item. The Examiner takes a position in the Final Office Action regarding being associated with an item. The Examiner states, in the Final Office Action, page 2, that each product of *Carter* has associated with it a group. The Examiner asserts that a product being associated with a group is analogous to associating a calculation code with an item. Because the only way a product would be associated with a group in *Carter* is being included in the group, the Examiner is essentially asserting that being included in a group is analogous to associating a calculation code with an item.

The Examiner takes a position in the Advisory Action regarding being applied to an item. According to the Examiner in the Advisory Action, the qualifying method is the act of determining whether a product will be included in a group. The Examiner appears to be asserting that by determining if the item is in the group determines whether to apply the code. Thus, the Examiner appears to be asserting that determining if a product will be included in a group is analogous to determining whether a calculation code is to be applied to an item.

These two positions cannot concurrently both be true. If a product is associated with a group, it is included in the group. If a product is included in a group, there is no reason to determine whether the product is to be included in a group. Therefore, it cannot be true that being included in a group is analogous to associating a calculation code with an item and determining if a product will be included in a group is analogous to determining whether a calculation code is to be applied to an item.

According to Applicant's claims, being associated with an item is distinct from being applied to an item. *Carter* does not teach associating the calculation code with an item and, using the qualifying method to determine whether to apply the calculation code to the item. Because *Carter* does not teach associating the calculation code with an item and, using the qualifying method to determine whether to apply the calculation code to the item, *Carter* does not anticipate Applicant's claims.

*Carter* also does not teach the calculation code having an associated qualifying method that is used to determine whether the calculation code is to be applied to the item because *Carter* does not teach a qualifying method.

Applicant's independent claims recite "wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item". Therefore, according to Applicant's claims, the code itself has the associated method. This method, which is associated with the code, is then used to determine if the code is to be applied.

The Final Office Action states:

As pointed out in the rejection to the claims above, Carter's groups represent Applicant's calculation code. As each product is associated with it a

group (calculation code) which determines whether the calculation code is to be applied to the item, the teachings of Carter clearly include a qualifying method.

Final Office Action, dated September 5, 2006, page 3.

If the Examiner is correct in his assertion that the group, as taught by *Carter*, teaches a calculation code, then the group itself must be associated with a method. In addition, this method must then be used to determine if its associated group is to be applied. This is not what is taught by *Carter*, however.

In the Advisory Action, the Examiner states that when items are placed in groups, a qualifying method must occur which determines if the item is in the group and thus whether to apply the code. The Examiner does not refer to any particular teaching of *Carter* that teaches a qualifying method. The Examiner merely asserts that one must exist.

*Carter* provides no teaching regarding a qualifying method. The Examiner does not point to any particular teaching of *Carter* that the Examiner believes is analogous to a qualifying method. Therefore, *Carter* does not anticipate Applicant's claims because *Carter* does not teach a qualifying method. Furthermore, *Carter* does not teach a calculation code having an associated qualifying method that is used to determine whether the calculation code is to be applied to the item. Because *Carter* does not teach a qualifying method, *Carter* does not anticipate Applicant's claims.

## **B. CONCLUSION**

*Carter* does not anticipate Applicants' claims because *Carter* does not teach wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item; associating the calculation code with an item; responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; and responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce an amount for the parameter for the item.

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## **CLAIMS APPENDIX**

The text of the claims involved in the appeal are:

2. A method for processing a parameter for an item in an electronic order processing system, said method comprising:

providing a plurality of calculation rules for calculating amounts for parameters of items;

associating one or more calculation rules from the plurality of calculation rules with a calculation code, wherein the one or more calculation rules are used to produce an amount for a parameter and wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item;

associating the calculation code with an item;

responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; and

responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce an amount for the parameter for the item; and

providing the amount to an output device.

3. A method for processing a parameter for an item as in claim 2, wherein the calculation rule may be modified and initiating application of the calculation code to the item remains the same.



4. A method for processing a parameter for an item as in claim 2, wherein said output device is one of (a) a printer, (b) a display device, (c) a storage medium, (d) a database and (e) a connection device.
5. A method for processing a parameter for an item as in claim 2, wherein the item is one of a plurality of items, the calculation code is one of a plurality of calculation codes associated with the item and the one or more calculation rules are selected from a plurality of calculation rules associated with the calculation code.
6. A method for processing a parameter for an item as in claim 2, wherein said associating said calculation code further comprises selectively associating said calculation code with said item.
7. A method for processing a parameter for an item as in claim 2, wherein each of the plurality of calculation rules has an associated allowable calculation attribute that determines whether the calculation rule may be combined with other calculation rules.
8. A method for processing a parameter for an item as in claim 7, wherein the allowable calculation attribute has a value selected from the group consisting essentially of in combination with, not in combination with, and in addition to.
10. An electronic order processing system for use in an ordering system responsive to a transaction request associated with an item, said electronic order processing system comprising:

a computer receiving the transaction request; and

a program executed on the computer for processing the transaction request and processing a parameter for the item, the program comprising:

- a plurality of calculation rules for calculating amounts for parameters of items;
- an association module for associating a calculation code with the item wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item;
- a calculation module for applying the calculation code to the item to produce an amount for a parameter for the item, wherein the calculation module initially associates one or more calculation rules with the calculation code; responsive to initiating application of the calculation code to the item, uses the qualifying method to determine whether to apply the calculation code to the item; and, responsive to a determination that the calculation code is to be applied to the item, uses the one or more calculation rules to produce the amount for the parameter for the item; and
- an application module for providing the amount to an output device.

(Previously presented): An electronic order processing system as in claim 10, wherein the calculation rule may be modified and initiating application of the calculation code to the item remains the same.

12. An electronic order processing system as in claim 10, wherein said output device is one of (a) a printer, (b) a display device, (c) a storage medium, (d) a database and (e) a connection device.

13. An electronic order processing system as in claim 10, wherein the item is one of a plurality of items, the calculation code is one of a plurality of calculation codes associated with the item and the one or more calculation rules are selected from a plurality of calculation rules associated with the calculation code.
14. An electronic order processing system as in claim 10, wherein said association module selectively associates said calculation code with said item.
15. An electronic order processing system as in claim 10, wherein each of the plurality of calculation rules has an associated allowable calculation attribute that determines whether the calculation rule may be combined with other calculation rules.
16. An electronic order processing system as in claim 15, wherein the allowable calculation attribute has a value selected from the group consisting essentially of in combination with, not in combination with, and in addition to.
26. A computer program product, in a computer readable medium, embodying a method for processing a parameter for an item, the method comprising the steps of:
- providing a plurality of calculation rules for calculating amounts for parameters of items;
  - associating one or more calculation rules from the plurality of calculation rules with a calculation code, wherein the one or more calculation rules are used to produce an amount for a parameter and wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item;

associating the calculation code with an item;  
responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; and  
responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce an amount for the parameter for the item; and  
providing the amount to an output device.

27. A computer program embodying a method for processing a parameter for an item as in claim 26, wherein the calculation rule may be modified and initiating application of the calculation code to the item remains the same.

28. A computer program embodying a method for processing a parameter for an item as in claim 26, wherein said output device is one of (a) a printer, (b) a display device, (c) a storage medium, (d) a database and (e) a connection device.

29. A computer program embodying a method for processing a parameter for an item as in claim 26, wherein the item is one of a plurality of items, the calculation code is one of a plurality of calculation codes associated with the item and the one or more calculation rules are selected from a plurality of calculation rules associated with the calculation code.

30. A computer program embodying a method for processing a parameter for an item as in claim 26, wherein said associating said calculation code further comprises selectively associating said calculation code with said item.

31. A computer program embodying a method for processing a parameter for an item as in claim 26, wherein each of the plurality of calculation rules has an associated allowable calculation attribute that determines whether the calculation rule may be combined with other calculation rules.

32. A computer program embodying a method for processing a parameter for an item as in claim 31, allowable calculation attribute has a value selected from the group consisting essentially of in combination with, not in combination with, and in addition to.

34. An electronic order processing system comprising:  
a computer-readable information storage medium;  
a procedure encoded on said storage medium for processing a parameter for an item, said procedure comprising:

providing a plurality of calculation rules for calculating amounts for parameters of items;

associating one or more calculation rules from the plurality of calculation rules with a calculation code, wherein the one or more calculation rules are used to produce an amount for a parameter and wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item;

associating the calculation code with an item;

responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; and

responsive to a determination that the calculation code is to be applied to the item,  
using the one or more calculation rules to produce an amount for the parameter  
for the item; and  
providing the amount to an output device.

35. An electronic order processing system as in claim 34, wherein the calculation rule may be modified and initiating application of the calculation code to the item remains the same.

36. An electronic order processing system as in claim 34, wherein said output device is one of (a) a printer, (b) a display device, (c) a storage medium, (d) a database and (e) a connection device.

37. An electronic order processing system as in claim 34, wherein the item is one of a plurality of items, the calculation code is one of a plurality of calculation codes associated with the item and the one or more calculation rules are selected from a plurality of calculation rules associated with the calculation code.

38. An electronic order processing system as in claim 34, wherein said associating said calculation code further comprises selectively associating said calculation code with said item.

39. An electronic order processing system as in claim 34, wherein each of the plurality of calculation rules has an associated allowable calculation attribute that determines whether the calculation rule may be combined with other calculation rules.

40. An electronic order processing system as in claim 39, wherein the allowable calculation attribute has a value selected from the group consisting essentially of in combination with, not in combination with, and in addition to.

41. An electronic order processing system for processing a parameter for an item in a distributed network having a first computer and a second computer, said system comprising:

- a computer-readable modulated carrier signal;

- a first initiation code embedded in said signal sent from said first computer to said second computer, said first initiation code to initiate a first module for associating a calculation code with said item, wherein the calculation code has an associated qualifying method that is used to determine whether the calculation code is to be applied to the item;

- a second initiation code embedded in said signal sent from said first computer to said second computer, said second initiation code to initiate a second module for applying said calculation code to said item to produce an amount, wherein said second module further comprises initially associating one or more calculation rules with said calculation code; responsive to initiating application of the calculation code to the item, using the qualifying method to determine whether to apply the calculation code to the item; and, responsive to a determination that the calculation code is to be applied to the item, using the one or more calculation rules to produce the amount; and

- a third initiation code embedded in said signal sent from said first computer to said second computer, said third initiation code to initiate a third module for providing said amount to an output device.

43. An electronic order processing system as in claim 41, wherein said second computer receives said signals and each operation within each of said first module, said second module and said third module may be modified and flow of execution amongst said first module, said second module remains the same.

44. An electronic order processing system as in claim 41, wherein said second computer receives said signals and each operation within each of said first module, said second module and said third module may be modified and flow of execution amongst said first module, said second module remains the same.



## **EVIDENCE APPENDIX**

There is no evidence to be presented.

## **RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.